

## **REMARKS**

Claim 17 has been amended. On the Office Action Summary page and at the top of p. 2 of the Office Action, the Examiner incorrectly lists only claims 17-19, 25 and 31-45 as pending. However, claims 17-45 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Restriction Requirement:**

Applicants maintain their traversal of the previously asserted restriction requirement. In this regard, Applicants filed a Petition pursuant to 37 C.F.R. § 1.144 on December 5, 2005. In the Response to Arguments of the current Office Action, the Examiner states, “[i]f Applicants assert that the Inventions are not patentably distinct, the Examiner will mostly likely withdraw the restriction”. However, as argued previously, it is the Examiner who has the burden to state a proper restriction requirement. As discussed in Applicants’ previous response (filed July 11, 2005) and in Applicants’ petition pursuant to 37 CFR 1.144, the Examiner has failed to state a proper restriction requirement for numerous reasons. As such, Applicants respectfully request the removal of the restriction requirement and request examination of all pending claims 17-45. A decision on Applicants’ Petition is respectfully requested.

### **Section 101 Rejection:**

The Examiner rejected claims 17-25 under 35 U.S.C. § 101, asserting, “the claimed invention is directed to non-statutory subject matter”. Applicants respectfully traverse this rejection for at least the following reasons.

In regards to claim 17, in the previous rejection, the Examiner suggested “reciting an object (e.g. computer, medium, etc.) or producing a result” (parenthesis by Examiner). The Examiner repeats this suggestion in the current rejection. In Applicants’ previous response, claim 17 was amended to specifically recite a computer system, as suggested

by the Examiner. Additionally, claim 17 has been amended to recite a processor and memory including program instructions. As Examiner is certainly aware "... a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory" as stated in the MPEP §2106 IV.B.1(a) (*emphasis added*). Thus, Applicants respectfully request removal of the § 101 rejection of claim 17 and its respective dependent claims.

Regarding claim 26, contrary to the Examiner's assertion, the subject matter recited by claim 26 is clearly statutory. Claim 26 recites, in part, receiving a purchasing request comprising goods, services, and supplier information, retrieving XML content in response to the purchasing request, and *transforming* the retrieved XML content into appropriate content suitable for an underlying markup language of an Internet browser used by a purchasing profession. Thus, the method of claim 26 clearly produces a "useful, concrete, tangible result."

The Examiner assert that Applicants' claims "recite software and software is not one of the four statutory classes of patentable subject matter." The Examiner's comment is irrelevant since the claims do not recite software *per se*. MPEP 2106.IV.B.2.(b) states that a process is statutory if it is "limited to a practical application in the technological arts" regardless of whether or not there is any pre- or post- process activity. The most famous example of this category is found in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) as discussed in MPEP 2106 where the court stated that the relevant claim was statutory because "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application ... because it produces 'a useful, concrete and tangible result' – a final share price".

Just like transforming data representing discrete dollar amounts to determine a final share price was considered a practical application and thus statutory in *State Street*,

the transformation of retrieved XML content into appropriate content suitable for an underlying markup language is a practical application and thus statutory. MPEP 2106.II.A states: “Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejection under 35 U.S.C. 101.” (emphasis added). As discussed above, claim 26 clearly recites a practical application in the technological arts. Therefore, the rejection is improper.

### **Section 103(a) Rejection:**

The Examiner rejected claims 17-30 under 35 U.S.C. § 103(a) as being unpatentable over White (“How Computers Work”). Applicants respectfully traverse this rejection for at least the reasons below.

Regarding claim 17, contrary to the Examiner’s contention, **White does not teach or suggest a computer system comprising a processor and a memory including program instructions executable on the processor to implement a Document Exchange (XDOC) framework for processing in-bound and out-bound documents in an electronic procurement system, wherein the XDOC framework comprises: an Extensible Markup Language (XML) content configuration file module configured to provide XML content gathered from a plurality of in-bound documents and applied to out-bound documents responsive to said in-bound documents.** In fact, White is completely silent regarding any sort of program instructions for a Document Exchange framework for processing in-bound and out-bound documents that includes an XML content language configuration file module.

The Examiner states, “[i]f Applicants desire the framework to have greater weight, the Examiner suggests placing the ‘framework’ within a functional recitation (instead of a non-functional recitation)” (parenthesis by Examiner). Claim 17 has not and does not recite the document exchange framework as non-functional descriptive material.

To the contrary, the document exchange framework clearly constitutes substantive and functional limitations in the claim. The Examiner is apparently equating any general computer system, such as taught by White, to be configured to implement a Document Exchange framework, as recited in claim 17. However, a computer system can only be considered configured to implement such a Document Exchange framework once loaded with the appropriate program instructions. White fails to mention anything about software or program instructions executable to implement a Document Exchange framework having the full functionality as recited in claim 17. Thus, White does not teach or suggest the limitations of Applicants' claims. The rejection of claim 17 is clearly not supported by the cited art and removal thereof is respectfully requested.

**Regarding claim 26, the Examiner has not even attempted to provide a *prima facie* rejection.** The Examiner fails to consider the actual language of claim 26. Instead, the Examiner merely rejects all of claims 17-30 together, stating, "White discloses a computer system". However, claim 26 does not recite a computer system. Instead, claim 26 recites specific actions of a method for providing Extensible Markup Language (XML) content from a database to a purchase order request in an electronic purchasing network.

Contrary to the Examiner's rejection, **White fails to teach or suggest any of the limitations of claim 26.** For example, White does not teach or suggest receiving a purchasing request cataloged in a plurality of in-bound documents by the electronic purchasing network, the purchasing request comprising goods, services and supplier information defining purchasing parameters specific and unique to a particular purchasing professional, as recited in claim 26. As noted above, the Examiner has cited any prior art that teaches or suggests this limitation of claim 26. White also fails to teach or suggest the only limitations of claim 26. The Examiner has completely ignored the specific language and limitations of claim 26.

As discussed in the M.P.E.P. at 2143 and as the Examiner is surely aware:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. (emphasis added).

The present rejection fails to meet any of these criteria in regard to each of claims 17-30. The Examiner has not provided any suggestion or motivation, either in White or in the knowledge generally available to one of ordinary skill in the art, to modify White. Instead, the Examiner merely states, "White teaches a computer system". A discussion of computer systems generally, as is White does not provide any suggestion or motivation to modify White to somehow teach or suggest the method recited in claim 26, for example.

Furthermore, White clearly and inarguably fails to teach or suggest all the claim limitations. For example, in regard to claim 26, the computer system taught by White does not include, nor does White mention, receiving a purchasing request cataloged in a plurality of in-bound documents, retrieving XML content in response to the purchasing request from data sources external and internal to the electronic purchasing network, and transforming the retrieved XML content into appropriate content suitable for an underlying markup language of an Internet browser, nor any of the other limitations recited in claim 26. In short, White has very little, if any, relevance to the subject matter of claim 26.

Moreover, as described in the M.P.E.P. at 706.02(j), when making a proper rejection under 35 U.S.C. 103, the Examiner should set forth in the office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the differences or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

In the present rejection, the Examiner has failed to set forth any of the four requirements outlined 706.02(j) of the M.P.E.P. Instead, the Examiner merely states, “White teaches a computer system”, which as noted above fails to teach or suggest the specific method recited Applicants’ claims.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be completely unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

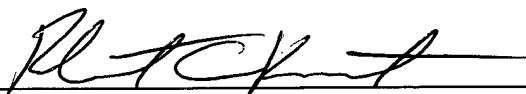
Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-90700/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,

  
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Date: September 13, 2006